



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Joseph F. Duffy, et al.		
Serial No.:	10/701,186	Case No.:	21167
Filed:	November 4, 2003		
For:	CYANOTHIOPHENE DERIVATIVES, COMPOSITIONS CONTAINING SUCH COMPOUNDS AND METHODS OF USE		

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This is in response to the Restriction Requirement dated December 10, 2004, a response to which is due by January 10, 2005. Reconsideration and allowance are respectfully requested.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on the date appearing below.

By RPJ Date 12/20/04
MERCK & CO., INC.

Claims 1-18 are pending. No claims are added or cancelled.

In the Office Action, the Examiner requires restriction and an identification of species under 35 U.S.C. § 121 to one of the following two claim groups:

Group I: Claims 1-16, covering compounds of formula (I) and compositions containing them; and

Group II: Claims 17 and 18, covering methods of treatment.

Applicants elect to continue prosecution of the claims in Group I, claims 1-16. This election is made with traverse. In response to the species election requirement for Group I, applicants designate the compound of Example 1, N-[3-cyano-5-(3-isobutyl-1,2,4-oxadiazol-5-yl)-4-methylthien-2-yl]-2-ethylbutanamide. This designation is made for purposes of facilitating the Examiner's search of the art, and it is made with the understanding that the election requirement will be withdrawn upon finding that an allowable generic claim is contained in the application.

Applicants respectfully traverse the restriction requirement as set forth below. The Examiner has characterized the method of treatment claims 17 and 18 as a "process of use". Applicants respectfully disagree. Method of treatment claims addressing the use of the compounds of formula I for treating diseases or conditions are properly combinable with the compound claims from which they depend. Neither of the Examiner's premises: (1) the process for using the product as claimed can be practiced with another materially different product, nor (2) the product as claimed can be sued in a materially different process of using the product, is on point. Both method of treatment claims depend from claim 1.

Applicants urge that the scope of claim 1 is acceptable for examination in its present form. Accordingly, it is believed that examination of the full scope of claim 1 is proper and rejoinder of claims 17 and 18 is appropriate.

In view of the arguments made, it is respectfully submitted that applicants have fully responded to the Office Action of December 10, 2004. It is urged that all claims are in allowable condition. The Examiner is therefore requested to withdraw the restriction requirement, examine all claims pending in the application, and to issue a notice of allowance to this effect. Favorable action is therefore earnestly solicited. If the Examiner has any questions, she is respectfully requested to telephone the undersigned.

Respectfully submitted,

By 
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